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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,818	08/22/2001	Jean-Michel Bernardon	016800-451	7237

7590

08/26/2003

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EXAMINER

JIANG, SHAOJIA A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/26/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,818

Applicant(s)

BERNARDON ET AL.

Examiner

Shaojia A Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on June 2, 2003 in Paper No. 17 wherein no claims are amended or cancelled. Currently, claims 2-6 and 8-17 are pending in this application.

As indicated in the previous Office Action January 31, 2003, Applicant's remarks filed on January 10, 2003 in Paper No. 14, with respect to the rejection of claims 2-6 and 8 made under 35 U.S.C. 112 second paragraph for the expression, "such period of time...the desired response" recited in the instant claims and the expression "PPAR" in claim 8 of record stated in the previous Office Action dated September 10, 2002 have been fully considered and found persuasive to remove the rejection.

Applicant's remarks filed on June 2, 2003 in Paper No. 17, with respect to the rejection of claims 9-12 made under 35 U.S.C. 112 second paragraph for the expression, recited in the instant claims of record stated in the previous Office Action dated January 31, 2003 have been fully considered and found persuasive to remove the rejection.

Applicant's remarks regarding claims 14-17 have been considered. It is noted that claims 14-17 are dependent from claim 2, not claim 1 which has been cancelled in Applicant's amendment filed July 11, 2002 in Paper No. 9.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-6 and 8-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernardon (5,763,487), for reasons of record stated in the Office Action dated January 31, 2003.

Applicant's remarks filed June 2, 2003 in Paper No. 17 with respect to this rejection of claims 1-6 and 8-17 made under 35 U.S.C. 102(b) in the previous Office have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art for the following reasons.

Applicants argue that Bernardon patent does not contain all elements of the instant claims. However, as indicated in the previous Office Action, Bernardon discloses that the active instant compounds including the particular elected compound (see col.3 lines 50-53) are useful in methods of treating dermatological, and skin and hair conditions/disorders broadly such as dermal or epidermal proliferations, a keratinization disorder, and skin aging photoinduced or chronological. See abstract, col.1-2, col.3 lines 50-53, Example 20 at col.16 and claims 12-25. Bernardon also discloses the employment of retinoids, particular vitamin D compounds, corticosteroid, particular α -hydroxy or α -keto acids, and ion channel blockers in the combination with the instant

compounds in methods therein (see col.6 lines 67). Bernardon further discloses that the administered route is topical (see col.7-8).

As discussed in the previous Office Action, one of ordinary skill in the art would clearly acknowledge that the disorders herein such as the barrier function of human skin, disorders of the secretion of epidermal lipids, photodermatoses or ulcers, and/or disorders of the metabolism of lipids read on the dermatological, and skin and hair conditions/disorders such as dermal or epidermal proliferations, a keratinization disorder, and skin aging photoinduced or chronological in Bernardon's method. Moreover, Bernardon's method inherently treats the barrier function of human skin, disorders of the secretion of epidermal lipids, photodermatoses or ulcers, and/or disorders of the metabolism of lipids, as claimed herein since Bernardon's method steps are same as the instant method steps. See *Ex parte Novitski*, 26 USPQ 2d 1389. Thus, Bernardon anticipates the claimed invention.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
August 14, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER

8/24/03